

Remarks

This is responsive to the Office Action mailed October 28, 2005. The remarks are proper, do not introduce new matter, do not require additional searching, and are not narrowing in view of a prior art rejection.

Errors/Unresolved Issues

At the outset, Applicant acknowledges with appreciation the Examiner issuing this second non-final action in view of the errors in the first action.

One error in the first action involved the Examiner construing Anderson 926's switch block 178 as anticipating the *closed tubular channel* of the present embodiments as claimed. Another error involved the Examiner not construing claim 2 as a means-plus-function claim in accordance with 35 USC 112 paragraph six.

Curiously, in this second action these errors are repeated. As for the first error, the Examiner now construes the U-shaped channel 150 of Anderson '926 as anticipating the *closed tubular channel* of the present embodiments, despite Applicant's explanatory distinction (see Applicant's Response of 8/22/2005, pg. 8) and without any rebuttal or comment thereto. As for the second error, it is repeated verbatim.

This case has been granted special status for accelerated examination. However, so far Applicant has endured an unnecessary delay in the issuance of valuable patent rights because neither the first nor the second action establish even a colorable prima facie case of anticipation substantiating the rejections.

Applicant has formally requested herewith a telephone interview with the Examiner's Supervisor, Ms. Field, in an attempt to remedy this impasse as expediently as possible in order to get this case moving forward on the merits.

Rejection Under Section 102(b)

Claims 1-21 were rejected as being anticipated by Anderson '926. This rejection is respectfully traversed.

Claim 1

The Examiner has not substantiated a prima facie case of anticipation because Anderson '926 does not identically disclose all the recited features of the present embodiments, including at least the following:

An array storage system...with a carrier from a plurality of different carriers differentiated by a characteristic array of tubular closed channels, each channel adapted for supportingly engaging a data storage device.
(excerpt of claim 1, emphasis added)

Sustaining a Section 102 rejection requires the Examiner make a factual finding that each and every limitation is found either expressly or inherently in a single prior art reference. *Celeritas Techs. Ltd. v. Rockwell Int'l Corp.*, 47 USPQ2d 1516 (Fed. Cir. 1998). The present embodiments as claimed contemplate an array storage system comprising a plurality of different carriers. The carriers are differentiated by a characteristic array of *tubular closed channels*, each *channel* adapted for supportingly engaging a data storage device.

In rejecting claim 1 the Examiner read the *tubular closed channels* on the U-shaped channels 150 of Anderson '926. FIG. 6 of Anderson '926 discloses a structural enclosure made of a bottom enclosure 122 attached to a top enclosure 124. Each of the disk drives 136, 138, 140, and 144 are attached to a separate mounting board, and are supported in the enclosure by sliding an edge of the mounting board through channels 150 that are attached to or formed in the bottom enclosure 122. (Anderson '926, col. 11 lines 5-13)

The Applicant reiterates that the channels 150 of Anderson '926, being U-shaped, are clearly recognizable to the skilled artisan as being open channels and thereby not *tubular closed channels* as in the present embodiments as claimed. Such a common meaning is consistent with usage of the claim language in the specification, such as in FIG. 5 and at page 7 lines 23-25, which discloses the *tubular closed channel* 218 as being defined by joinder of the opposing paired surfaces 220, 222 and 224, 226. (see also, for example, specification page 3 lines 1-3; page 3 lines 8-11; page 3 lines 16-19; page 9 lines 24-26; page 16 lines 24-26.

The Examiner read the U-shaped channel 150 on the *tubular closed channels* straightforwardly, giving no explanatory details in the detailed action as to how an open-shaped channel anticipates a *tubular closed channel*; the Applicant can only surmise it is due to another mistake. Whatever the Examiner's intended basis, the U-shaped channel 150 does not define a *tubular closed channel* adapted for supportingly engaging the data storage device. The Examiner's claim construction is unreasonable because it ignores both plain meaning and the explicit definition in the specification of the claim term *tubular closed channel*. *In re Morris*, 43 USPQ2d 1753 (Fed. Cir. 1997).

Accordingly, again the Examiner has not substantiated a prima facie case of anticipation because Anderson '926 does not identically disclose all the features of the present invention as claimed. Reconsideration and withdrawal of the present rejection of claim 1 are respectfully requested.

Furthermore, and particularly in view of the Examiner's reticent lack of response to Applicant's prior distinction, the Examiner has not even substantiated a colorable argument for Anderson '926 anticipating the recited *closed tubular channel* of claim 1. Accordingly, the second action does not satisfy the Examiner's obligations of thoroughness and completion in considering the patentability of the invention as claimed. 37 CFR 1.104(a) As such, in the absence of an allowance the next action on the merits rightfully cannot finally reject claim 1.

Claim 2

Applicant reiterates (see Applicant's Response of 8/22/2005, pages 9-11) that the Examiner has not substantiated a prima facie case of anticipation because Anderson '926 does not identically disclose all the recited features of the present embodiments, including at least the following:

A multiple disc array comprising...means for urging the data storage device against the circuit board.
(excerpt of claim 2, emphasis added)

The *means for urging* element of claim 2 invokes 35 U.S.C. §112, sixth paragraph. Accordingly, the Examiner is obliged to construe the means clause as covering the disclosed structure and equivalents thereof performing the identical function of the claimed embodiments. See *B. Braun Medical, Inc. v. Abbott Lab.*, 43 USPQ2d 1896, 1900 (Fed. Cir.

1997); *In re Donaldson Co. Inc.*, 26 USPQ2d 1845 (Fed. Cir. 1994)(*en banc*); *In re Dossel*, 42 USPQ2d 1881 (Fed. Cir. 1997); *Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, Para. 6*, 65 FR 38510. A failure to do so is reversible error.

The Applicant has explicitly identified the function associated with the recited *means for urging* as being damping the data storage device and positively connecting the data storage device with the electrical connector. (see, for example, specification pg. 8 beginning at line 4; pg. 10 beginning at line 3; FIGS. 7 and 8 and the corresponding discussions thereof)

The Examiner repeated the following in rejecting claim 2 over Anderson '926: "the means 156 for urging is characterized by a fastener for attaching the data storage device 136, 138, 140 to a channel surface." (Office Action of May 20, 2005, pg. 2, Office Action of October 28, 2005, pg. 2) The rejection is erroneous because item 156 of Anderson '926, on which the Examiner relies, is an electrical connector. But Anderson '926 is wholly silent regarding any structure of the electrical connector that serves to enhance or preserve the mechanical and electrical integrity between the data storage device and the circuit board.

When the means element is properly construed, it is clear that Anderson '926 does not disclose or suggest any structure capable of the identical function as the present embodiments as claimed. Accordingly, independent claim 2 and the claims depending therefrom are allowable over the art of record. Reconsideration and withdrawal of the rejection of claim 2 and the claims depending therefrom are respectively requested.

Furthermore, and particularly in view of the Examiner's reticent lack of response to Applicant's prior distinction, the Examiner has not even substantiated a colorable argument for anticipating the recited *means for urging* of claim 2. Accordingly, the second action with

respect to the rejection of claim 2 does not satisfy the Examiner's obligations of thoroughness and completion in considering the patentability of the invention as claimed. 37 CFR 1.104(a) As such, in the absence of an allowance the next action on the merits rightfully cannot finally reject claim 2 or any claim depending therefrom.

Claim 10

The Examiner has not substantiated a prima facie case of anticipation because Anderson '926 does not identically disclose all the recited features of the present embodiments, including at least the following:

A carrier...comprising channel surfaces defining a tubular closed passage....
(excerpt of claim 10, emphasis added)

For at least the same reasons as discussed above for claim 1, the U-shaped channel 150 of Anderson '926 does not anticipate the *channel surfaces defining a tubular closed passage* of the present embodiments as claimed. As above, the Examiner's claim construction is unreasonable because it ignores both plain meaning and the explicit definition in the specification of the claim term *channel surfaces* and *tubular closed passage*. *In re Morris*, 43 USPQ2d 1753 (Fed. Cir. 1997).

Anderson '926 cannot sustain the Section 102 rejection because it fails to identically disclose all the features of the present invention as claimed. Reconsideration and withdrawal of the present rejection of claim 10 and the claims depending therefrom are respectfully requested.

Furthermore, and particularly in view of the Examiner's reticent lack of response to Applicant's prior distinction, the Examiner has not even substantiated a colorable argument

for anticipating the recited *channel surfaces defining a tubular closed passage* of claim 10. Accordingly, the second action does not satisfy the Examiner's obligations of thoroughness and completion in considering the patentability of the invention as claimed. 37 CFR 1.104(a) As such, in the absence of an allowance, the next action on the merits rightfully cannot finally reject claim 10 or any claim depending therefrom.

Claim 17

The Examiner has not substantiated a prima facie case of anticipation because Anderson '926 does not identically disclose all the recited features of the present embodiments, including at least the following:

A method...comprising providing a carrier defining an array of tubular closed channels for supportingly engaging data storage devices....
(excerpt of claim 17, emphasis added)

For at least the same reasons as discussed above for claims 1 and 10, the U-shaped channel 150 of Anderson '926 does not anticipate the *tubular closed channels* of the present embodiments as claimed. As above, the Examiner's claim construction is unreasonable because it ignores both plain meaning and the explicit definition in the specification of the claim term *tubular closed channels*. *In re Morris*, 43 USPQ2d 1753 (Fed. Cir. 1997).

Anderson '926 cannot sustain the Section 102 rejection because it fails to identically disclose all the features of the present invention as claimed. Reconsideration and withdrawal of the present rejection of claim 17 and the claims depending therefrom are respectfully requested.

Furthermore, and particularly in view of the Examiner's reticent lack of response to Applicant's prior distinction, the Examiner has not even substantiated a colorable argument

for anticipating the recited *tubular closed channels* of claim 17. Accordingly, the second action does not satisfy the Examiner's obligations of thoroughness and completion in considering the patentability of the invention as claimed. 37 CFR 1.104(a) As such, in the absence of an allowance the next action on the merits rightfully cannot finally reject claim 17 or any claim depending therefrom.

Conclusion

This is a complete response to the Office Action mailed October 28, 2005, as understood. The Applicant respectfully requests that the Examiner reconsider the application and allow all of the pending claims. The Applicant has submitted herewith a request for telephone interview with the Examiner's Supervisor, at a time to be determined by the Supervisor if, after reviewing the amendments herein and before the next action on the merits, it is determined that all pending claims are not in condition for allowance. The telephone interview is necessary to ensure this case proceeds on the merits where neither the first nor the second action did so.

Respectfully submitted,

By: 

Mitchell K. McCarthy, Registration No. 38,794
Randall K. McCarthy, Registration No. 39,297
Fellers, Snider, Blankenship, Bailey and Tippens
100 N. Broadway, Suite 1700
Oklahoma City, Oklahoma 73102
Telephone: (405) 232-0621
Facsimile: (405) 232-9659
Customer No. 33900